UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,954	02/09/2001	Charles P. Tresser	CHA9-2001-0001US1	7575

23550 7590 11/26/2003

HOFFMAN WARNICK & D'ALESSANDRO, LLC
3 E-COMM SQUARE
ALBANY, NY 12207

EXAMINER	
ELISCA, PIERRE E	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/779,954	Applicant(s) Charles R. Tresser
	Examiner Pierre E. Elisca	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 09/12/2003.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-19* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

RESPONSE

1. This Office action is in response to Applicant's response, filed on 09/17/2003.

2. Claims 1-19 are pending.

Claim Rejections - 35 USC § 103 (a)

3. The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable by Clark et al. (U.S. Pat. No. 5,710,889) in view of Jia et al. (U.S. Pat. No. 5,991,402).

As per claims 1, 5-7, 9, 10, 12-14, and 16-19 Clark substantially discloses an electronic delivery system that delivering services directly to a customer facility at any time requested by the customer. The customer connects to the system whenever desired to access each of the services, and the interface device stores and routes messages between the customers and each of the service providers at the respective times when the customers' facilities and the service providers' facilities are operative (which is readable as Applicant's claimed invention system for delivering institutional data to a customer), comprising:

an institutional server, wherein the institutional server includes a system for separately serving a first database containing private and a second database containing (see., fig 1, abstract, col 3, lines 18-35, repository and archive facility);

a client, wherein the client includes a system for displaying a merged version of the private and public data (or security) see., figs 15, 17, 20, 23, 24, 28, col 6, lines 37-47, col 14, lines 10-22, col 21, lines 16-25). It is to be noted that Clark fails to explicitly disclose an encrypted version of the private data and an unencrypted version of the public data. However, Jia discloses a method/system that enables software-on-demand and software subscription services based on a dynamic transformation filter. An encrypted material installed on the computer is encrypted by decrypting a first version of the material to produce an unencrypted version (see., abstract, col 5, lines 55-67, col 6, lines 1-67, col 7, lines 1-26, col 10, lines 8-13). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the global financial service of Clark by including the limitation detailed above as taught by Jia because such modification would shield direct access to the financial services.

As per claim 2, Jia discloses the claimed limitations wherein the client includes a mechanism for decrypting the encrypted private data (see., abstract, col 5, lines 55-67, col 6, lines 1-67, col 7, lines 1-26).

As per claim 3, Jia discloses the claimed limitations wherein said making the customer anonymous to the service provider (see., abstract, fig 1, item 108).

As per claim 4, Jia discloses the claimed limitations wherein the system for making the customer anonymous to the service provider includes a mechanism for determining a service level available to the customer (see., abstract, col 3, lines 20-44).

As per claims 8, 11, and 15 Jia discloses the claimed limitations wherein the encrypted version of the private data is encrypted using a public key infrastructure protocol (see., col 6, lines 64-67, col 7, lines 1-18).

REMARKS

5. In response to Applicant's arguments, Applicant argues the prior art of record (Clark and Jia) fail to disclose:

a. " to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations". The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. " missing portions of the Examiner's arguments at the middle of page 3, specifically "institutional server". As stated above, page 3 recites "an institutional server" which is the exact copy of claim 1.

c. " storing an encrypted copy of the private data and an unencrypted copy of the public data with an intermediary service provider". However, the Examiner respectfully disagrees since Jia discloses a method/system that enables software-on-demand and software subscription services based on a dynamic transformation filter. An encrypted material installed on the computer is encrypted by decrypting a first version of the material to produce an unencrypted version (see., abstract, col 5, lines 55-67, col 6, lines 1-67, col 7, lines 1-26, col 10, lines 8-13). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the global financial service of Clark by including the limitation detailed above as taught by Jia because such modification would shield direct access to the financial services.

CONCLUSION

6. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

(703) 305-7687

Pierre Eddy Elisca

Patent Examiner

November 25, 2003